

Docket No.: 5486-0218PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jerry DUNIETZ et al.

Before the Board of Appeals

Application No.: 09/552,262

Confirmation No.: 4106

Filed: April 19, 2000

Art Unit: 2175

For: PRE-COMPUTING AND ENCODING
TECHNIQUES FOR AN ELECTRONIC
DOCUMENT TO IMPROVE RUN-TIME

Examiner: W. L. Bashore

July 14, 2007

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants submits herewith a Reply Brief in triplicate as required by 37 C.F.R. § 1.192.

This Appeal Brief responds to the Examiner's Answer dated May 14, 2008.

For clarity, the issues presented in the Appeal Brief filed February 19, 2008, will be repeated, and the Reply to the Examiner's Answer will correspond structurally to the arguments previously raised in the Appeal Brief.

I. ISSUES ON APPEAL

The issues to be resolved in this application are:

(a) Claims 1-2, 5, 7, 9, and 16-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tada et al. (hereinafter "Tada"), U.S. Patent No. 5,745,745 patented 4/28/1998.

(b) Claims 3-4, 8, and 22-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tada in view of "Open eBook Publication Structure 1.0" (hereinafter "Open eBook") published 9/16/99.

(c) Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tada in view of Carus, et al., (hereinafter "Carus") U.S. Patent No. 6,035,268.

(d) Claims 10 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tada in view of Carus.

(e) Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tada.

(f) Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Open eBook.

(g) Claims 24-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Open eBook in view of Tada.

The rejections of claims 1-35 are being appealed.

II. NEW POINTS OF ARGUMENT RAISED BY THE EXAMINER'S ANSWER

Appellants are providing this Reply Brief to respond to new points of argument raised in the Examiner's Answer. Appellants do not disagree with paragraphs (1) - (9) of the Examiner's Answer. The specific new points of argument that are raised in paragraph (10) to which the Appellants disagree as follows:

1. The Examiner introduces new arguments and asserts that Tada includes or may be reasonably interpreted as including teaching for replacing a tag with an alias (replacing tags (stings) with identification codes). Furthermore, the Examiner characterizes claim 1 as merely reciting that the alias is a pre-defined representation for a tag, and further asserts that Tada teaches inserting a control code, which is a flag, to form an encoded structure. Appellants' response to these assertions is discussed below, beginning at paragraph A.

2. The Examiner introduces new arguments concerning Tada's teachings of the alleged relationships maintained between tags (i.e., alias), flags (control codes/variables) along with logical structure identification numbers (see also, Tada, at least Figures 11, 12, 15, and 28).

Furthermore, the Examiner argues that in addition to the documents as discussed in Tada being typically "parsed" during runtime, (i.e., at the time of document rendering). The Examiner argues that Tada's control codes are integers. Appellants' response to these assertions is discussed below, beginning at paragraph B.

3. The Examiner introduces new arguments for the purported teaching of Tada in combination with Carus, by alleging that Carus does teach comparing a left and right term to determine if they [the left and right term] are part of a single word and if the left and right terms are not part of a single word, inserting a word break flag between the left and right terms in col. 2, lines 62 – col. 3, line 31 and col. 5, lines 51-67. Appellants' response to these assertions is discussed below beginning at paragraph C.

4. The Examiner introduces new arguments for the purported teachings of Tada by alleging that even if Tada does not teach that there is no search flag is conditionally inserted based on determining whether the portion is to be displayed for the viewing by a reading device; it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tada to have created the claimed invention. The Examiner goes on by asserting it would have been obvious and desirable to have used the search exclusion technique of Tada to have excluded portions which are not to be displayed by a viewing device from searching. The Examiner goes on to assert that this [exclusion technique] would have corresponded to the goal of Tada of improving run-time search operations as described in col. 6, lines 30 – col. 7, line 20. Appellants' response to these assertions is discussed below, in the following section beginning with paragraph D.

5. The Examiner introduces new arguments for the purported combination of Open eBook with Tada teaches the advantage of decreased search time as a result of pre-computing and on coding the content file. Appellants' response to this assertion is discussed below in the following section beginning with paragraph E.

III. REPLY

- A. **The Examiner introduces new arguments and asserts that argued teaching of Tada includes or may be reasonably interpreted as including teaching for replacing a tag with an alias (replacing tags (stings) with identification codes). Furthermore, the Examiner characterizes claim 1 as merely reciting that the alias is a pre-defined representation for a tag, and further asserts that Tada teaches inserting a control code, which is a flag, to form an encoded string. Appellants' response to these assertions is discussed below.**

1. Independent claim 1 is patentable because Tada fails to disclose or suggest the claimed feature "separating a tag from the content with a separation variable" recited in claim 1.

As previously asserted in the Appeal Brief, Tada does not teach combining the alias and the flag and separating the combination from the content with a separation variable. Support for Appellants' claimed separation variable may be found on at least page 17 of Appellants' specification.

At step 410, a code character is inserted to separate markup language from the actual content of the e-book file. For example, the code may be a Unicode character 0x0000. The Unicode character is inserted before and after each start and end tag. Subsequent encoding of the markup (discusses herein) should be constrained so that the Unicode character 0x0000 never occurs within the representation of a start or end-tag or elsewhere within the content, but rather occurs only as a first and last character of each start an end tag.

Accordingly, and as previously asserted, the start and end tags are distinct entities from the claimed separation variable as the separation variable separates the tags from the content. At no point does Tada describe "replacing the tag with an alias, wherein the alias is a pre-defined representation for the tag".

Despite the Examiner's further and similarly raised allegations, that such a teaching is found within Tada in col. 22 at lines 6-20, Appellants had on numerous prior occasions raised this same section as clear evidence to exactly the contrary point. For example, in the current Final Office Action, at page 2, col. 22, lines 13-28, Tada states:

A logical structure identification number corresponding to the logical structure discriminator is obtained from the correspondence table Specifically, in the example . . . the start tag '<Title>' is detected . . . and the logical structure identification number '1' is obtained

... At the search database creation step 35, in place of the start tag, a specific control code "α" representative of the start of the logical structure is written and the obtained logical structure identification number and logical structure length are written after the control code "α". The end tag is deleted, and the control codes such as text ID and eot are written for the creation of the search database.

Appellants respectfully submit that the identification number in Tada is replacing content such as "a character string" and is not replacing a tag with an alias, the alias being a pre-defined representation for the tag. Moreover, as stated above in Tada, a start tag is replaced by a control code "α." Appellants contend that the control code "α" is representative of a start of a logical structure and does not disclose an alias as claimed.

B. The Examiner introduces new arguments concerning Tada's teachings of the alleged relationships maintained between tags (i.e., alias), flags (control codes/variables) along with logical structure identification numbers (see also, Tada, at least Figures 11, 12, 15, and 28).

Furthermore, the Examiner argues that in addition to the documents as discussed in Tada being typically "parsed" during runtime, (i.e., at the time of document rendering). The Examiner argues that Tada's control codes are integers.

1. Independent claim 1 is patentable because Tada fails to disclose or suggest the claimed feature of "replacing the tag with an alias, wherein the alias is a pre-defined representation for the tag" of independent claim 1.

In addition, claim 1 is allowable over Tada for at least an additional reason. Tada fails to teach at least the claimed element of "replacing the tag with an alias, wherein the alias is a pre-defined representation for the tag" as recited in step (b) of claim 1. The June 18, 2007 Final Office Action (hereinafter the Current Final Office Action) relies on Tada, contending that "Tada teaches replacing the tag with an alias in col. 22 lines 6-20." Current Final Office Action, page 2. Col. 22 lines 13-28 of Tada states:

A logical structure identification number corresponding to the logical structure discriminator is obtained from the correspondence table Specifically, in the example . . . the start tag '<Title>' is detected . . . and the logical structure identification number '1' is obtained

... At the search database creation step 35, in place of the start tag, a specific control code "α" representative of the start of the logical structure is written and the obtained logical structure identification number and logical structure length are written after the control code "α". The end tag is deleted, and the control codes such as text ID and eot are written for the creation of the search database.

At no point in the above description does Tada describe "replacing the tag with an alias, wherein the alias is a pre-defined representation for the tag" as recited in the claim. Rather, this portion of Tada merely describes obtaining an identification number, the identification number replacing logical structure discriminator (such as "a character string after the start character "<" and before the end character ">"). Col. 22, lines 10-11. Appellants respectfully submit that identification number in Tada is replacing content such as "a character string" and is not replacing a tag with an alias, the alias being a pre-defined representation for the tag.

Moreover, as stated above in Tada, a start tag is replaced by a control code "α." Appellants contend that the control code "α" is representative of a start of a logical structure and does not disclose an alias (ex. pre-defined integer) as claimed. Therefore, Appellants

respectfully submit that replacing a start tag with control code does not disclose, teach, or suggest, the claimed feature of "replacing the tag, with an alias, wherein the alias is a pre-defined representation for the tag." As Tada fails to teach this claimed feature, Appellants submit that for at least this additional reason independent claim 1 is patentable over the combination.

The Examiner has attempted to stretch the teaching in Tada to imply that a control code "α" is an integer. Appellants assert that clearly the control "α" is not, as defined, as an integer. Insofar as this mere allegation has been employed by the Examiner, attempting to stretch the alleged support found within Tada, Appellants submit that this attempt fails to do anything further than merely offer a circumstantial basis by which a general proposition could be entitled to strict claim construction and interpretation. As such, Appellants submit that for at least these additional reasons, independent claim 1 is clearly patentable over the asserted combination.

C. The Examiner introduces new arguments for the purported teaching of Tada in combination with Carus, by alleging that Carus does teach comparing a left and right term to determine if they [the left and right term] are part of a single word and if they are left and right terms are not part of a single word, inserting a word break flag between the left and right terms in col. 2, lines 62 – col. 3, line 31 and col. 5, lines 51-67.

Appellants continue to assert that Carus fails to teach comparing a left and right term to determine if they are part of a single word and if the left and right terms are not part of a single word, inserting a word break between the left and right terms.

The context of this particular assertion needs to be applied in total to the three-step method as recited in claim 10. As such, and for at least this basis, and as previously asserted, the

Examiner's allegation that Carus allegedly teaches determination of word/page break which can be reasonably interpreted as interpreting a word break flag between characters, fails to arrive to the elemental description found within at least step B of method claim 10. Clearly, determining whether the tag is within a single word, is not found with Tada or Carus, for example the current Final Office Action admits that Tada does not teach comparing a left and right term to determine if they are part of a single word, see Final Office Action, page 8. The Final Office Action then attempts to rely upon Carus to make up for this deficiency. However, Carus describes a structure in which the associated character-transition tag identifies the existence of a concatenation between successive characters, a break between successive characters or an unknown transition between successive characters. See Carus, col. 3, lines 28-32.

- D. The Examiner introduces new arguments for the purported teachings of Tada by alleging that even if Tada does not teach that there is no search flag is conditionally inserted based on determining whether the portion is to be displayed for the viewing by a reading device; it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Tada to have created the claimed invention. The Examiner goes on by asserting it would have been obvious and desirable to have used the search exclusion technique of Tada to have excluded portions which are not to be displayed by a viewing device from searching. The Examiner goes on to assert that this would [exclusion technique] have corresponded to the goal of Tada of improving run-time search operations as described in col. 6, lines 30 – col. 7, line 20.**

In response to the allegation it would have been obvious to have employed the exclusion technique of Tada to arrive at the excluded portions which are not to be displayed by a viewing device from searching, the Appellants again respond that this amounts to an over stretching by the Examiner in employing the alleged teachings and obvious modification to Tada to arrive at the instant claimed invention. Insofar as this does not amount to impermissible hindsight,

Appellants believe that this is again a circumstantial attempt to provide the most general basis by which to attack a specific claim limitation.

E. The Examiner introduces new arguments for the purported combination of Open eBook with Tada teaches the advantage of decreased search time as a result of pre-computing and on coding the content file.


Yet again, the Examiner is attempting to circumstantially apply an alleged teaching in Tada to modify the Open eBook reference to arrive at Appellants' claimed invention. That is to say, the Examiner is asserting that Tada does teach a content file which is pre-computed and encoded to minimize run-time requirements in col. 1, lines 7-13; col. 21, lines 50-64; col. 22, lines 6-20; and col. 22, lines 24 – col. 23, line 24. Again, Appellants believe that this amounts to an over-stretching of the Tada reference to provide what is lacking with regards to Open eBook for at least the basis by which the cited portions in the current Final Office Action on pages 11-13 set forth the factual assertions made by the Examiner. The Examiner alleges it would have been obvious and desirable to have used the content file pre-computing and on coding is taught by Tada to have enabled fast run-time search operations on an Open eBook, when is often implemented on a low-power portable reading device. See, for example, Final Office Action, pages 11 and 12. Again, Appellants believe that the combination of references is completely absent of any motivation so disclosed for making such a combination. And the general allegation by the Examiner has failed to meet the burden for a *prima facie* case under 35 U.S.C. § 103 from which there should be some explicit indication in one or more of the references so as to indicate the basis by which one of ordinary skill in the art would be so motivated to seek one reference in view of the other.

IV. CONCLUSION

Appellants rely on the arguments set forth in Appellants' Appeal Brief for those issues the Examiner has merely repeated those assertions set forth in his claim rejections. For all of the reasons set forth above, each of the rejections in the Examiner's Answer dated May 14, 2008, is improper. It is therefore respectfully requested that the Examiner be reversed on all grounds.

Dated: July 14, 2008

Respectfully submitted,

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